

REMARKS

Claims 1-25 are currently pending in the application. Claims 1-3 (in part), 4, 7-11 (in part), and 12-21 are withdrawn from consideration. Claims 1-3 (in part), 5-6, 7-8 (in part), 11, and 22-25 are currently stand rejected under 35 U.S.C. § 103(a).

Claims 1 and 22 are herein amended to change the language of the method claim from “comprising” to “consisting of.” Applicants respectfully submit that support for the amendment is found in the application Examples 1 and 2, pp. 11-12.

Claim 10 is herein amended to correct the spelling of subarachnoid.

Applicants respectfully submit that no new matter is added with such amendments.

35 U.S.C. § 103 Rejections (Obviousness)

The Office Action newly rejects claims 1-3 (in part), 7-11 (in part) and 22-25 as being unpatentable for reasons of obviousness over Bechgaard et al in view of PDR (Valium brand of diazepam injection) and Steppuhn et al. (see Office Action p. 3, top).

The Examiner states that although “Bechgaard et al (USPN 5,397,771) does not particularly teach the administration of its diazepam composition in the form of an injection”, because the “PDR teaches a composition comprising diazepam and

benzyl alcohol employed in a method of treating seizures” and the PDR further teaches that “the composition is administered intramuscularly and intravenously”, and because “Steppuhn et al. teaches that diazepam in sesame oil can be administered subcutaneously” then the presently claimed invention would have been obvious since “one of ordinary skill in the art would have been motivated to administer the composition of Bechgaard subcutaneously because intraconversion

of dosage forms and routes of administration are within the skill of the artisan and are therefore obvious.” See Office Action, p. 3, third para. through p. 4, third para., generally.

Applicants respectfully reiterate the previous arguments recited in Responses A and B, filed May 28, 2002 and October 17, 2002, respectively with regards to Bechgaard et al.. Applicants further stress that because the primary object of Bechgaard et al. is to optimize nasal administration because it was surprisingly found that nasal administration achieves peak plasma concentrations nearly as fast as seen with intravenous administration (see Abstract and col. 3, lines 40-48). Also, as stated previously in Response A (see p. 4, second full para.), the Bechgaard patent is based on a change in route of administration – from intravenous to nasal. Yet in the present case, the Office Action now asserts that “because intraconversion of dosage forms and routes of administration are within the skill of the artisan” (see Office Action, p. 4, third para.) it would have been obvious to change the surprising and novel nasal/mucosal route of administration of Bechgaard et al. to subcutaneous administration, never mind that it was apparently not obvious for Bechgaard et al. to change the route of administration from intravenous to nasal.

In addition, regarding the Bechgaard et al. requirement for n-glycofuroyl, the Office Action states that “the instant claims do not require this component.” See Office Action, p. 4, fifth para. With respect to claims 1 and 22 as now amended, which now require a method for treating ... with a lipophilic (claim 1)/non-estrogenic (claim 22) lipophilic agent consisting of: ...” would not have

been obvious in light of Bechgaard et al, even in combination with the PDR for Valium and Steppuhn et al.

There is no motivation to combine the references in Bechgaard et al. and no motivation to modify the route of administration in Bechgaard et al. Even assuming that the availability of the PDR reference places a diazepam composition with benzyl alcohol for the treatment of seizures in the knowledge generally available in the art, and the Steppuhn et al. patent places subcutaneous administration of a diazepam in sesame oil in the knowledge generally available in the art, there are two critical elements of a prima facie case of obviousness still lacking, without which the Examiner has failed to make the case.

First, there is no expectation of success, because the entire novelty and non-obviousness of Bechgaard et al. lies in the surprising results seen with rapid peak plasma concentrations when the route of administration is nasal/mucosal and NOT intravenous or anything else.

Second, given that Bechgaard et al. teaches away from needle forms of administration, there is no motivation to combine a reference for nasal/mucosal administration with others leading back to intravenous (PDR) or with a different

formulation of a diazepam administered subcutaneously when both require needles for the routes of administration, something anathema to Bechgaard et al.

Applicants respectfully submit that merely because references are available in the art does not mean that there is any motivation to combine them or any expectation of success if they are combined. Therefore, Applicant

respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all pending claims are in condition for allowance. Reconsideration of the claims and a notice of allowance are therefore requested.

Applicants hereby petition for a three-month extension of time and enclose a check in the amount of \$465. Applicants also request that deposit account number 19-4972 be charged for any additional fees that may be required for the timely consideration of this application.

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Respectfully submitted,



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